

REMARKS

A. Status of the Claims

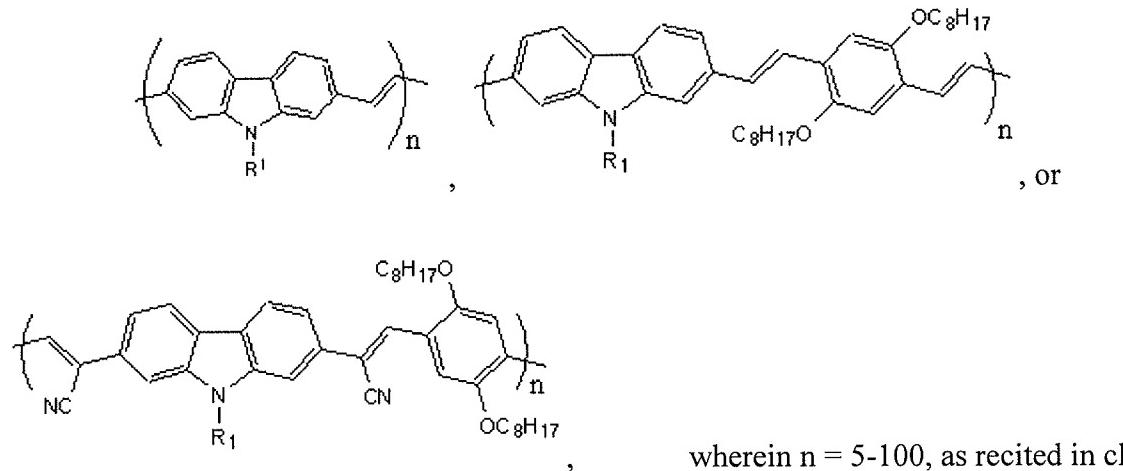
Claims 75-85 and 98-105 are pending in the application, and claims 98-102 stand withdrawn. Thus, claims 75-78, 80, 81, 83, 84 and 103-105 are under examination and stand rejected, variously, under 35 U.S.C. §112, first and second paragraphs. Objections are lodged against claims 79, 82 and 85. The specific grounds for rejection, and applicant's response thereto, are set out in detail below.

B. Renumbering of Claims and New Claim

The examiner has indicated that claims 103-105 be renumbered as claims 140-142. However, the national phase of this application was entered with revised claims numbering 1-102. Indeed, the examiner has previously overlooked this fact when issuing an incorrect restriction requirement based on claims 1-139 (October 15, 2007) which was subsequently corrected to be correctly based on claims 1-102 (December 12, 2007). Reconsideration and withdrawal of the objection is therefore respectfully requested.

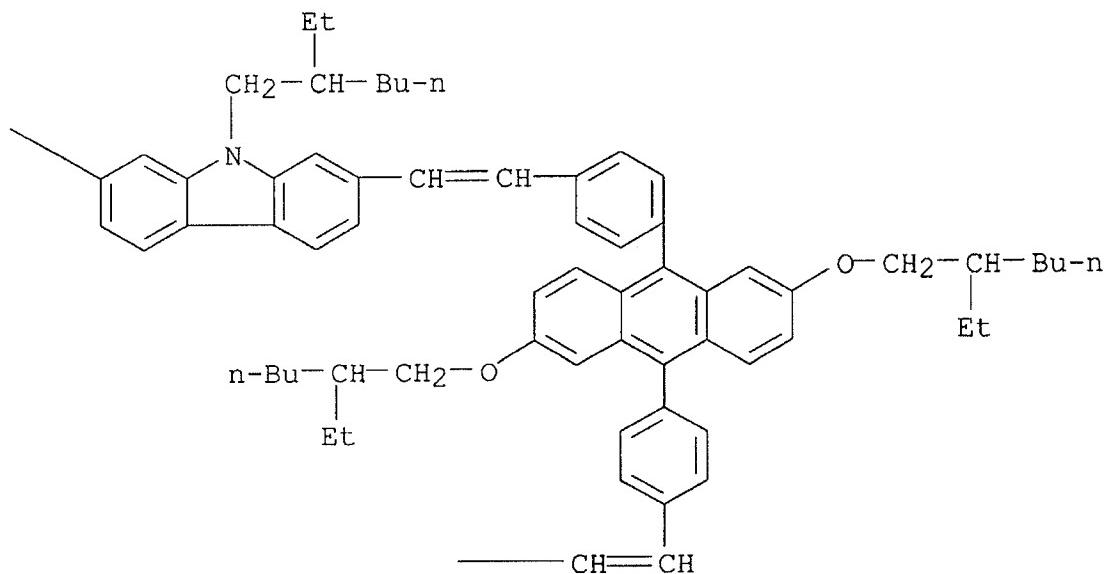
Applicants also note that new claim 106 is being submitted. This claim is similar to claim 75 prior to the insertion of the "homopolymer" language to which the examiner now objects, but includes structures for repeating monomers. The Chen *et al.* reference does **not** provide a disclosure of a polymer having repeating monomers of the structures now set forth in claim 106. If the examiner disagrees, applicants specifically request that the examiner point out a teaching in the reference that provides such a structure, as the cited compound, Poly [[9-(2-ethylhexyl)-9H-carbazole-2,7-diyl]-1,2-ethenediyl-1,4-phenylene[2,6-bis[(2-ethylhexyl)oxy]-9,10-anthracenediyl]-1,4-phenylene-1,2-ethenediyl] does not provide a species of repeating monomer of one of the following:

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wherein n = 5-100, as recited in claim 106.

Rather, as illustrated below, the repeating unit of Chen *et al.* contains far more than the carbazole units of claim 106:



Applicants submit that under no reasonable construction of Chen *et al.* can this molecule be seen as a species of that now claimed.

C. Support for Previous Amendments/New Matter Rejection

In a previous response, applicant amended claim 75 to include the recitation of “wherein the polymer is a homopolymer comprising repeating monomers consisting of the following structure” According to the examiner, this amendment constitutes “new matter” as not adequately supported by the specification as filed.

The examiner is incorrect in arguing that there is insufficient support for this claim. Again, it appears that the crux of the examiner’s concerns is that there is insufficient support for “homopolymers,” as opposed to polymers generally. Indeed, this **must** be the case as the inserted structures derive from identical disclosure in original claims 76, 80 and 83.

The definition of polymers in the specification, provided at paragraph [0057], states that the polymers “may” comprise different monomers. “May” clearly indicates this an optional embodiment, thus contemplating that the polymers may also **not** comprise different monomers, namely, they may comprises the **same** monomers. Thus, of the two choices – homopolymers or heteropolymers – the specification **clearly contemplates both**. As such, there is no credibility to the examiner’s argument that homopolymers are not described. The most recent action completely fails to address the specifics of this disclosure and their relevance to support for claim 75.

Further, the examiner is again reminded that the test for written description is not a formalistic inquiry. Much to the contrary, the test looks at whether a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification. If this burden is met, then the adequate written description requirement is met. *See, e.g., Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116. It has long been settled that *ipsis verbis* support for a term such as “homopolymer” is not required. *Martin v. Johnson*, 454 F.2d 746, 751 (CCPA 1972) (stating

“the description need not be in *ipsis verbis* [i.e., ‘in the same words’] to be sufficient”). Rather, “[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.” MPEP § 2163(II)(A)(3)(a).

In the present case, each aspect of claim 75 is *explicitly* provided in the specification except for a literal reference to the term “homopolymer.” As explained above, a skilled artisan would have clearly understood that applicant has also contemplated homopolymers given the definition of polymers. Additionally, Example 7 of the specification provides a non-limiting synthesis of the above referenced PCV homopolymer. Note that the only monomer in the reaction medium in Example 7 is compound 12. Polymerization of only one monomer *necessarily results in a homopolymer*. Further support for homopolymers are discussed below in this response.

In sum, both science and common sense would inevitable lead a person of ordinary skill in the art to conclude that applicant had possession of homopolymers as presently claimed when the application was filed. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

D. Indefiniteness Rejection

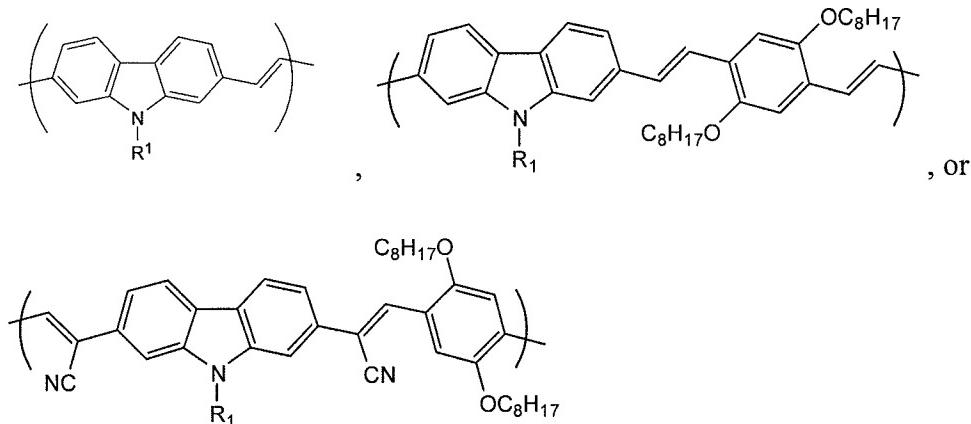
Claims 75-78, 80, 81, 83, 84 and 103-105 are rejected under 35 U.S.C. § 112, second paragraphs, for allegedly being indefinite. The examiner continues to argue that a “polymer comprising” a recited reaction product “fails to disclose all of the various monomer units that could be present.” The examiner notably cites not one single case to support this extreme view of definiteness – not surprisingly since it is completely at odds with the established case law. *See* MPEP § 2111.03. Thus, applicants again traverse.

The MPEP clearly provides the following highly relevant guidance on the use of generic chemical structures and the issue of definiteness:

A claim to a chemical compound is not indefinite merely because a structure is not presented or because a partial structure is presented. For example, the claim language at issue in *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) referred to a chemical compound as a “*polypeptide of at least 24 amino acids having the following sequence.*” A rejection under 35 U.S.C. 112, second paragraph, for failure to identify the entire structure was reversed and the court held: “*While the absence of such a limitation obviously broadens the claim and raises questions of sufficiency of disclosure, it does not render the claim indefinite.*” Chemical compounds may be claimed by a name that adequately describes the material to one skilled in the art. See *Martin v. Johnson*, 454 F.2d 746, 172 USPQ 391 (CCPA 1972). *A compound of unknown structure may be claimed by a combination of physical and chemical characteristics. See Ex parte Brian, 118 USPQ 242 (Bd. App. 1958).* A compound may also be claimed in terms of the process by which it is made without raising an issue of indefiniteness.

MPEP §2173.05(t) (emphasis added). Improperly, the most recent action completely ignored this line of argument, and applicants specifically request that examiner address this case law in the event the rejection is maintained.

Claim 75 (and new claim 106) provides the following chemical structures for the claimed polymers:



As explained above, the MPEP confirms that this type of claim language is definite under 35 U.S.C. § 112, second paragraph.

Applicant requests that the indefiniteness rejection be withdrawn for at least these reasons.

E. Conclusion

In light of the foregoing, Applicant respectfully submit that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicant's representative at (512) 536-3020.

Respectfully submitted,

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Date: June 1, 2010